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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,399	04/06/2001	Steven D. Stoecker	10007124-1	5151

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EXAMINER

MILIA, MARK R

ART UNIT PAPER NUMBER

2622

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/828,399

Applicant(s)

STOECKER, STEVEN D.

Examiner

Mark R. Milia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/12/02 & 1/12/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Figure 1 (132), Figure 4A (300) and (306). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6, 10-13, 15, 19, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6148148 to Wain et al.

Regarding claim 1, Wain discloses a system for selecting a particular size image to print, comprising: a computer adapted to receive an electronic image file (see column 6 lines 58-67), and a photograph generation software component in communication with the computer, the photograph generation software component adapted to analyze the electronic image file and present to a user a plurality of image formats from which the user selects a desired format (see column 7 lines 1-46).

Regarding claim 10, Wain discloses a method for selecting a particular size image to print, the method comprising the steps of: providing an electronic image file to a computer (see column 6 lines 58-67 and column 7 lines 1-46), selecting the electronic image file (see column 7 lines 29-46), and presenting to a user a plurality of image formats from which the user selects a desired format with which to print the selected electronic image file (see column 7 lines 9-13 and line 58-column 8 line 5).

Regarding claim 19, Wain discloses a method for printing a passport format image, the method comprising the steps of: providing an electronic image file to a computer (see column 6 lines 58-67 and column 7 lines 1-46), selecting the electronic image file (see column 7 lines 29-46), scaling the selected image file based on a predetermined print format, the predetermined print format corresponding to a passport photograph format (see column 8 lines 24-29), and printing the selected image file in the passport photograph format (see column 7 line 53-column 8 line 5).

Regarding claims 2 and 11, Wain discloses the system discussed in claims 1 and 10, and further discloses a printer adapted to print the electronic image tile in the selected image format (see column 7 line 58-column 8 line 5).

Regarding claims 3 and 12, Wain discloses the system discussed in claims 2 and 11, and further discloses wherein one of the plurality of image formats is a passport size photograph (see column 7 lines 9-13).

Regarding claims 4 and 13, Wain discloses the system discussed in claims 1 and 10, and further discloses wherein the image format is chosen from the group consisting of wallet size, visa size, 4"x6", 5"x7", and 8"x10" (see column 7 lines 9-13 and column 9 lines 20-34, reference states the option of a portrait size picture which is known to be of a conventional size such as 4"x6", 5"x7", or 8"x10" and reference also teaches the ability to take pictures of full length standing or seated poses and therefore the claimed element is anticipated by the reference).

Regarding claim 6 and 15, Wain discloses the system discussed in claims 1 and 10, and further discloses wherein the photograph generation software component allows a user to customize the image format (see column 8 lines 6-29).

Regarding claim 23, Wain discloses the system discussed in claim 19, and further discloses wherein the electronic image file corresponds to a photograph (see column 7 line 29-column 8 line 5).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 7, 14, 16, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wain as applied to claims 1, 10, and 19 above, and further in view of U.S. Patent Application Publication No. 2001/0004406 to Enomoto.

Wain does not disclose expressly (*claims 5, 14, and 20*) wherein the photograph generation software component automatically selects an image format and (*claims 7, 16, and 21*) wherein a user of the photograph generation software component selects a portion of the electronic image file to be printed in the desired format.

Enomoto discloses (*claims 5, 14, and 20*) wherein the photograph generation software component automatically selects an image format (see paragraphs [0078], [0080], [0083]-[0087], and [0104]-[0111]) and (*claims 7, 16, and 21*) wherein a user of the photograph generation software component selects a portion of the electronic image file to be printed in the desired format (see paragraphs [0083]-[0087]).

Wain & Enomoto are combinable because they are from the same field of endeavor, generation of passport photographs.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the automatic image format selection and main subject extraction of Enomoto with the system of Wain.

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The suggestion/motivation for doing so would have been to provide the correct print size generation after a user selects the portion of the picture that is to be printed.

Therefore, it would have been obvious to combine Enomoto with Wain to obtain the invention as specified in claims 5, 7, 14, 16, 20, and 21.

Claims 8, 17, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wain as applied to claims 1, 10, and 19 above, and further in view of U.S. Patent Application Publication No. 2001/0026633 to Abdel-Mottaleb et al.

Wain does not disclose expressly a face recognition software component configured to select a portion of the electronic image file to be printed in the desired format.

Abdel-Mottaleb discloses a face recognition software component configured to select a portion of the electronic image file to be printed in the desired format (see paragraphs [0026]-[0043]).

Wain & Abdel-Mottaleb are combinable because they are from the same field of endeavor, manipulation of digital images.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the face recognition method of Abdel-Mottaleb with the system of Wain.

The suggestion/motivation for doing so would have been to provide a passport photograph generation system that would ensure the picture that was taken by the user was actually one of the head and shoulders.

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Therefore, it would have been obvious to combine Abdel-Mottaleb with Wain to obtain the invention as specified in claims 8, 17, and 22.

Claims 9, 18 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wain as applied to claims 1, 10, and 19 above, and further in view of U.S. Patent No. 6226105 to Fukushi.

Wain does not disclose expressly a scanner including the photograph generation software component.

Fukushi discloses a scanner including the photograph generation software component (see column 6 lines 37-63).

Wain & Fukushi are combinable because they are from the same field of endeavor, processing images by selected size.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the scanner of Fukushi with the system of Wain.

The suggestion/motivation for doing so would have been to allow a preexisting photograph to be used to generate a passport photo.

Therefore, it would have been obvious to combine Fukushi with Wain to obtain the invention as specified in claims 9, 18, and 24.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. To further show state of the art refer to U.S. Patent numbers 6453078 (Bubie et al.), 6687020 (Hanagami et al.), 6408132 (Ishikawa), and 5828461

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(Kubo et al.) and U.S. Patent Application Publication numbers 2002/0093568

(Chumbley) and 2003/0133044 (Akiyama et al.).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (703) 305-1900. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached at (703) 305-4712. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark R. Milia
Examiner
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